

REMARKS / ARGUMENTS

I. General Remarks and Disposition of the Claims

Please consider the application in view of the following remarks. Applicants thank the Examiner for the careful consideration of this application including the references that Applicants have submitted in this case.

At the time of the Office Action, claims 15-18, 20-31 and 82 were pending in this application. Claims 15-18, 20-31 and 82 were rejected in the Office Action. By this paper, claims 15 and 21 have been amended, claims 23-27 and 31 have been rejoined and their designations returned to their original indicators, and claims 47-68 and 83 have been indicated as canceled. These amendments are intended to conform the claims to the Examiner's Amendment as detailed in the Notice of Allowance mailed March 25, 2010. All the amendments are made in a good faith effort to advance the prosecution on the merits of this case. It should not be assumed that the amendments made herein were made for reasons related to patentability. Applicants respectfully request that the above amendments be entered and further request reconsideration in light of the amendments and remarks contained herein.

II. Remarks Regarding Double-Patenting Rejections

A. Rejections Over *Pauls*

Claims 15-18, 20-31 and 82 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-22, 27 and 29-34 of U.S. Patent No. 7,475,728 to Pauls *et al.* (hereinafter "*Pauls*").

The Examiner has characterized both sets of claims as being "drawn to a method of drilling comprising adding a viscosified aqueous fluid (claim 27 in '728 patent) and poly(orthoester) as a degradable material (diverting agent in '728 patent and bridging agent in the present application)." Office Action at 4. However, *Pauls* and the present application are directed to distinct methods of using different fluids. Specifically, the claims of *Pauls* require that a filter cake be in the well bore prior to "contacting the filter cake with a treatment fluid comprising . . . a degradable diverting agent" See *Pauls*, claims 16, 30. Thus, the material responsible for degrading the filter is contained in the fluid contacting the filter cake, not the filter cake itself. As an example, the filter

cake of *Pauls* may comprise calcium carbonate, which does not degrade without a degradation agent. See *Pauls*, claim 32.

In contrast, independent claim 15 of the present application requires “forming a self-degrading filter cake comprising the bridging agent within the formation” where the “bridging agent [] is a degradable material.” Thus, the degradable material is a part of the bridging agent itself and is placed in the subterranean formation as a component of the filter cake. Independent claim 15 does not require that any additional fluids be contacted with the filter cake to degrade the filter cake. Independent claim 15 also requires “permitting the filter cake to self-degrade.” Thus, the component of the claim that contains the degradable material is different in both *Pauls* and the present application, and the methods of degrading the filter cake are distinct. Thus, the limitations of the claims of the present application are not obvious over the claims of *Pauls*.

Accordingly, Applicants respectfully submit that the double-patenting rejection over *Pauls* has been overcome, and respectfully request the withdrawal of the rejection of claims 15-18, 20-31 and 82 under the judicially created doctrine of obviousness-type double patenting.

B. Rejections over *Schriener*

Claims 15-18, 20-31 and 82 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 7,497,278 to *Schriener et al.* (hereinafter “*Schriener*”).

The Examiner has characterized both sets of claims as being “drawn to an oilfield method including drilling a subterranean formation comprising adding a viscosified aqueous fluid and poly(orthoester) as an additive (breaker in ‘278 patent and bridging agent in the present application).” Office Action at 4-5. However, *Schriener* and the present application are directed to distinct methods of using different fluids. Specifically, the claims of *Schriener* all require “contacting at least a portion of the filter cake with a breaker fluid comprising an orthoester composition” and “allowing at least a portion of the filter cake to degrade.” Thus, the breaker for the filter cake is contained in the breaker fluid, not the filter cake itself. In order to degrade the filter cake, the breaker

fluid is contacted with the filter cake after the filter cake is formed. Thus, the claims of *Schriener* are not directed to a self-degrading filter cake.

In contrast, independent claim 15 of the present application requires "forming a self-degrading filter cake comprising the bridging agent within the formation" where the "bridging agent [] is a degradable material." Thus, the degradable material is a part of the bridging agent itself and is placed in the subterranean formation as a component of the filter cake. Independent claim 15 does not require that any additional fluids be contacted with the filter cake to degrade the filter cake. Independent claim 15 also requires "permitting the filter cake to self-degrade." Thus, the component of the claim that contains the degradable material is different in both *Schriener* and the present application, and the method of degrading the filter cake is distinct. Thus, the limitations of the claims of the present application are not obvious over the claims of *Schriener*.

Accordingly, Applicants respectfully submit that the double-patenting rejection over *Schriener* has been overcome, and respectfully request the withdrawal of the rejection of claims 15-18, 20-31 and 82 under the judicially created doctrine of obviousness-type double patenting.

III. No Waiver

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art.

SUMMARY

In light of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe that no fees are due in association with the filing of this response. Should the Commissioner deem that any fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefore, and direct that any additional fees be charged to McDermott Will & Emery's Deposit Account No. 500417, Order Number 086108-0172.

Respectfully submitted,

/Iona N. Kaiser/

Iona N. Kaiser
Reg. No. 53,086
McDermott Will & Emery
1000 Louisiana, Suite 3900
Houston, TX 77002-5005
Telephone: 713.653.1724
Facsimile: 713.739.7592
Email: ikaiser@mwe.com

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